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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/087,359   | 03/01/2002  | Toshihiro Yoshida    | 791_188             | 3319             |
| 25191  | 7590        | 08/18/2005           | EXAMINER            |                  |
| BURR & BROWN<br>PO BOX 7068<br>SYRACUSE, NY 13261-7068 |             |                      | YUAN, DAH WEI D     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1745                |                  |
| DATE MAILED: 08/18/2005                                |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/087,359

Applicant(s)

YOSHIDA ET AL.

Examiner

Dah-Wei D. Yuan

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20,21,23-46 and 54 is/are pending in the application.
- 4a) Of the above claim(s) 20,21 and 29-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**ELECTRODE BODY EVALUATION METHOD AND LITHIUM  
SECONDARY CELL USING THE SAME**

Examiner: Yuan

S.N. 10/087,359

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August 12, 2005

**Detailed Action**

1. The Applicant's amendment filed on July 1, 2005 was received. The specification was amended. Claim 54 was amended. A Rule 132 Declaration filed by Mr. Yoshida was received.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action issued on March 3, 2005.

***Specification***

3. The amendment filed July 1, 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: where a capacity of said lithium secondary cell is at least 2Ah, and a ratio of a limit discharging current to said cell capacity is at least around 30; [t]he 8 Ah battery of Embodiment 9 was manufactured again in exactly the same manner as described above, except that the positive and negative electrodes were reduced in size by a factor of 4. Consequently, the battery capacity after initial charging of all cells was approximately 2 Ah. This 2 Ah battery exhibited a limit discharging current (A) of about 60 A, which as expected, is about 1/4 of the limit discharging current of the 8 Ah battery according to

Embodiment 9. The ratio of limit discharging current to battery capacity for this 2 Ah battery was about 30.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 54 and dependent claims 23-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The recitation “where a capacity of said lithium secondary cell is at least 2Ah, and a ratio of a limit discharging current to said cell capacity is at least around 30” is not disclosed in the instant specification. If applicant believes said terms are fully defined, it is requested that applicant indicates column and line, and/or figure with number, identifying the support of the limitation.

***Response to Arguments***

6. Applicant’s arguments filed on July 1, 2005 have been fully considered but they are not persuasive.

*Applicant's principle arguments are*

*The amendment to the specification is an inherent characteristic of the batteries already described in the present specification, its introduction into the specification does not introduce new matter.*

In response to Applicant's arguments, please consider the following comments.

In the proposed amendment to the specification, Applicant discloses the positive and negative electrode are reduced in size by a factor of 4. As a result, the battery capacity after initial charging of the cell was approximately 2 Ah as opposed to the batteries of 8 Ah in the originally filed specification. See Paragraph 131 of instant disclosure. The ratio of limit discharging current to battery capacity in the currently amended claim 54 is entirely deduced from the newly disclosed data by the Applicant. If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type (adding a specific mode of practicing the invention not described in the application as filed) should be treated as new matter. See MPEP 2165.

*Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dah-Wei D. Yuan whose telephone number is (571) 272-1295. The examiner can normally be reached on Monday-Friday (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dah-Wei D. Yuan  
August 12, 2005

A handwritten signature in black ink, appearing to read 'Dah-Wei D. Yuan', with a stylized flourish extending to the right.

**DAH-WEI YUAN**  
**PRIMARY EXAMINER**